

REMARKS

Reconsideration of the present application in view of the foregoing amendments and the following remarks is respectfully requested. By this amendment, Applicants have amended claims 1-2, 10-11, 15, 24-25 and 28, cancelled claims 13 and 36 and added new claims 44-45. Thus, claims 1-8, 10-15, 24-37 and 44-45 remain in the application with claims 16-23 and 38-43 having been previously withdrawn due to a restriction requirement.

Claim Rejections - 35 USC § 112

In the official action, the Examiner rejected claims 1-8, 10-15, 25-31 and 33-37 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as follows:

Claims 1-8, 10-15, 25-31 and 33-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because of the following reasons:

Since the apparatus of claim 1 includes at least one filter disk (as claimed), it is unclear how the filter disk can be separated from the apparatus (itself) in lines 8-9 of claim 1. Did applicant intend to claim "... such that apparatus said center post member is separated from the at least one filter disk by sliding the apparatus center post member out from the at least one filter disk.." For the same reasons, "apparatus" in line 12 should be changed to "center post member". The indefinite rejection of claim 1 also applies *mutatis mutandis* to claim 25.

Claims 7-8, 10-15, 25-31 and 33-37 are also rejected since they suffer the same defects as the claims from which they depend.

In response to the rejection, Applicants believe that they have amended independent claims 1 and 25 obviate the Examiner's rejection and that applicants have followed the Examiner's suggestion and an action acknowledging same is respectfully requested.

Claim Objections

Further, in the official action, the Examiner objected to claim 28 as follows:

Claim 28 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Since the remote location is not part of the apparatus, it is not seen how further describing the remote location further structurally defines applicant's invention (claim 25 already requires the filter disc to be separable from the apparatus).

In response to the Examiner's objection, applicants have amended claim 28 to place claim 28 in proper dependent form as depending from a method claim. Such action is believed to obviate the Examiner's objection and an action acknowledging same as respectfully requested

Specification Objection

In the official action the Examiner objected to the specification as follows:

The abstract is objected to because of misspelled and duplicate words.

Applicants have made a good faith effort to review the abstract and was unable to determine specifically what misspelled words and/or duplicate words to which the objection was directed. If the Examiner would be so kind as to specify the specific words to which he is objecting, applicants will be more than happy to work with the Examiner to provide the correct spelling therefore and/or to eliminate any unnecessary duplication and an action acknowledging same is respectfully requested.

Claim Rejections - 35 USC § 103

In the Official Action, the Examiner rejected claims 1, 5 and 10-15 under 35 U.S.C. 103(a) as being unpatentable over DE 19541965 Cl, hereinafter '965 in view of Blackmore (US. 1,701,556) as follows:.

11. Claims 1, 5 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 19541965 Cl, hereinafter '965 in view of Blackmore (US. 1,701,556). '965 teaches an oil filter including a plurality of filter disks 10 clamped between end plates 11 and 12 and including a center post member (17+14) wherein the disks are slidable thereon. The apparatus is configured such that elements 17, 14, 10, 11, 12 and 9 are lifted out of the casing 2 in unison for servicing/replacing the disks. At such time the cover plate 11 is removed and the disks are slid off the post member. Either or both of elements 9 and 16 are considered to be the claimed "adapter member" that is "operatively connected" to the post member 14 whenever the disks are "operatively position" [as in claim 1]. '965 doesn't teach the post member (17+ 14) to include an attachment means including a means for lifting the disk (Note that the equivalent structure in the specification for this "means for" limitation is the eyebolt, hoist ring, or lifting eye of page 7, lines 19-25.) However such is taught by Blackmore. Blackmore also teaches an oil filter including a plurality of disks 24 (more than 56) [as in claims 10-11]] that also includes an attachment means including a means including for facilitating lifting (36) of the disks [as in claim 1]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention for the top of the post member (17+ 14) to include the eyebolt 36 of Blackmore,

since Blackmore teaches the benefit of facilitating removal of the filter assembly by e.g. a hook so that the hands of the operator will not be soiled (page 1, lines 78-81). As for claim 5, upon removal of the filter assembly from the casing 2, the limitations thereof are met. As for claim 15, the disks can slide over the end of the post member. As for claim 13, the adapter member 9 includes a flow passage therethrough. As for claim 14, the exact shape (e.g. semi-circular) of the aperture (discharge passage) is within ordinary skill and is insufficient per se for patentability of the claim. For example in uses requiring a small volumetric flow rate, it is obvious for the discharge passage to have a smaller cross-sectional area of a semicircle. As for claim 12, Blackmore teaches the idea of the end of a post 32 to be threaded to attach to a complimentary threaded portion. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the end of the adapter 9 of '965 to be threaded and to engage a complementary threaded opening (7), since Blackmore teaches the benefit of rigidly securing the assembly.

As the Examiner knows, the PTO recognizes in MPEP §2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process .. The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...* The initial evaluation of *prima facie* obviousness thus relieves both the examiner and applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

As Judge Newman astutely observed, "the determination of whether a *prima facie* case of obviousness has been made is a critical decision that controls the evidentiary procedures and burdens before the PTO." *In re Geiger*, 815 F.2d 686, 690, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987) (Newman, Circuit Judge, concurring).

The Examiner may reject a claim as obvious (albeit novel) over a single prior art reference on the ground that it would have allegedly been obvious to a person of ordinary skill in the art to change what the reference shows to that which is claimed. The change, it may be asserted, is a matter of standard design technique. More often, however, the PTO will assert obviousness on the basis of the combination of two or more prior art references, e.g., asserting that the primary reference teaches or shows most of that which is claimed and the secondary reference shows or suggests the element (s) or other teaching missing from the primary reference.

In either the single reference or plural references situation, "the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the

art' when the invention was unknown and just before it was made." MPEP §2142. The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed "as a whole." *Id.*

As the examiner knows, the CCPA and Federal Circuit case law provide grounds for attacking an obviousness rejection for want of a *prima facie* showing.

***All Claim Limitations Must Be Considered, Especially
When Missing From the Prior Art***

When evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. A case in point is *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), where the court reversed an obviousness rejection because the examiner ignored a material, claimed, temperature limitation which was absent from the reference.

Another case in point is *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969), where the court held that printed indicia on a measuring cup, while not *per se* patentable subject matter, had to be considered in determining patentability, explaining as follows:

The fact that printed matter by itself is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination. Here there is a new and unobvious functional relationship between a measuring receptacle, volumetric indicia thereon indicating volume in a certain ration to actual volume, and legend indicating the ration, and in our judgment the appealed claims properly define this relationship.

Thus, if printed matter is functionally related to the other elements of the invention, the printed matter must be considered in determining whether the claimed invention is nonobvious in view of the prior art.

In *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir 1984), the Federal Circuit reversed a district court holding of invalidity of patents relating to the use of molded polystyrene sheets in the formation of concrete walls, for failure to consider the invention "as a whole." The basic error of the trial court was in judging the "idea" behind the invention. The Federal circuit held that:

The invention cannot be tested on the basis of whether the "idea" of using molded polystyrene is patentable. Under the patent statute, Title 35 U.S.C., "ideas" are not patentable; claimed structures and methods are. Reducing a claimed invention to an "idea," and then determining patentability of that "idea" is error. [citation omitted.] Analysis properly begins with the claims, for they measure and define the invention. 727 F.2d at 1527-27, 220 USPQ at 1024.

The district court in *Jones* had treated the structural differences between the claimed invention and the prior art as the invention itself. Rejecting this denigration of the claimed invention "as a whole," the Federal Circuit observed that:

The "difference" may have seemed slight (as has often been the case with some of history's great inventions, e.g., the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art. *Id.* at 1528, 220 USPQ at 1024.

The Federal Circuit has continually cautioned against myopic focus on the obviousness of the difference between the claimed invention and the prior art rather than on the obviousness *vel non* of the claimed invention as a whole relative to the prior art as §103 requires. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986).

As the Examiner will note, applicants have extensively amended the independent claims in an effort to clarify the specific combination Applicants intend to be the subject thereof. Specifically, Applicants have clarified the structure of the adapter member and specified how it interacts with a liquid outlet. Such specific description is not believed to be disclosed, suggested or taught by any of the currently applied references.

Since the Examiner has failed to make a prime facie case of obviousness, Applicants respectfully submit that the claims, as currently amended, are allowable and an action acknowledging same is respectfully requested.

In the official action, the Examiner rejected claims 2-3, 24-26, 28, 33-37 under 35 U.S.C. 103(a) as being unpatentable over '965, in view of Blackmore as applied above and in further view of FR 2,460,154, hereinafter "154" as follows:

Claims 2-3, 24-26, 28, 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over '965, in view of Blackmore as applied above and in further view of FR 2,460,154, hereinafter "154". As expanded above '965 in view of Blackmore teaches the limitations of claims 28 and 33-37 but does not teach a motor-powered lifting apparatus. As shown in figure 5, '154 teaches a motor powered lifting apparatus [as in claims 2-3 and 25-26]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the lifting apparatus of '154 in the invention of the modified '965, since '154 teaches the benefit of removing a filtering apparatus from a housing for the servicing/replacing of the filter units. Upon modification of '965 with that taught in Blackmore and '154, the claim method of claim 24 is also taught.

Claims 6 and 29 are rejected under 35 U.S.C 103(a) as being unpatentable over '965 as respectively modified in the rejections of claims 1 and 25 above and in further view of Kiefer (US 781,830).

Kiefer teaches a threaded hook received by a threaded post [as in claims 6 and 29]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the threaded configuration of Kiefer in the inventions of the modified '965, since Kiefer teaches the benefit of a means for lifting a filter disc assembly.

Claims 8 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over '965 as respectively modified in the rejections of claims 1 and 25 above and in further view of Boggs et al. (US. 3,666,107).

Boggs teaches a lifting member (10+ 16+ 18) welded to a center post [as in claims 8 and 31]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the modified means for lifting of '965 to be welded to the post member (17+ 14) thereof as in Boggs, since Boggs teaches the benefit of a means for lifting a filter disc assembly.

Claims 7 and 30 rejected under 35 U.S.C. 103(a) as being unpatentable over '965 as respectively modified in the rejections of claims 1 and 25 above and in further view of Lock (US. 2,630,610). Lock teaches a swiveled hook ring. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the ring of the modified '965 to be swiveled as in Lock since such would allow the connection to the lifting means to be rapidly made.

Claims 4 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over '965 in view of Blackmore and '154 as applied above and in further view of Broyden et al. (US 4,635,903). Broyden teaches a manually operated chain hoist [as in claims 4 and 27]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the lifting means to be manually operated since Broyden does not require a lot of physical strength to operate the chain hoist and the operator can precisely raise the load to a particular height without worrying about accidentally dropping the load.

As stated above, Applicants have extensively amended the independent claims and believe that the specific structure incorporated therein is no disclosed, suggested or taught by any of the currently applied references, either taken alone or in combination, and an action acknowledging same is respectfully requested.

Since the Examiner has failed to make a prime facie case of obviousness, Applicants respectfully submit that the claims, as currently amended, are allowable and an action acknowledging same is respectfully requested.

Thus, after entry of the above amendments, it is Applicant's position that the application is now in condition for allowance and an action acknowledging same is respectfully requested.

If after reviewing this amendment, should the Examiner have questions or require additional information, he is cordially invited to call the undersigned attorney, so this case may receive an early notice of allowance. Such action is earnestly solicited.

Any fees or charges due as a result of filing the present paper may be charged against Deposit Account No. 033879.

Respectfully submitted,



R. Thomas Payne,
Reg. No. 30,674
Attorney for Applicant(s)

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CUNO Incorporated
400 Research Parkway
Meriden CT. 06450
T - (203) 238-8737
F - (203) 238-8716
tpayne@cuno.com